

REMARKS

This responds to the final Office Action and the Notice of Appeal. No claims are amended, canceled, or added; as a result, claims 25-44 are still pending in this application.

Double Patenting Rejections

Claims 25-44 were rejected under the judicially created doctrine of double patenting over claims 1-26 of U.S. Patent No. 5,889,941.

Claims 25-44 were rejected under the judicially created doctrine of double patenting over claims 1-13 of U.S. Patent No. 6,014,748.

Applicant will submit a terminal disclaimer upon notification that the claims are allowable over Dethloff.

§102 Rejection of the Claims

Claims 25-44 were rejected under 35 USC § 102(e) as being anticipated by Dethloff et al. (U.S. 4,968,873).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

Claims 25 – 34. Independent claim 25 recites: “acquiring personalization equipment characteristics for particular personalization equipment. . .” and “translating the internal script into a data stream in accordance with the personalization equipment characteristics.” Applicant respectfully submits that neither b) acquiring personalization equipment characteristics, nor d) translating the internal script into a data stream to the particular personalization equipment is taught by Dethloff.

The Office Action relies on column 16, lines 14-35 to supply these elements. Dethloff states at column 16, lines 14-16, “FIG. 17 is block diagram of the (ViVo) card issuing machine,” and further at column 16, lines 21-23, “Operations by both the operator and the visitor and the machine function are show in the flowchart of Fig. 18.” FIG 18 discloses that the operator enter the following information: “Enters Name + passport No,” and “enters DMK 4,000” “enters ZERO” and “enters: VIVO 500” in addition to entering “start” and “OK” in response to prompts

on the Operator's Display. Further, FIG. 18 discloses the visitor entering the following information: "Enters PIN," and "Enters Sub-user's (M-) Pin," and enters "OK" in response to prompts on the Visitor's Display.

Applicant submits that nowhere in FIG. 18 does Dethloff teach "acquiring personalization equipment characteristics for particular personalization equipment" as recited in claims 25. In fact, the phrase "personalization equipment" do not appear in Dethloff. Because Dethloff does not disclose acquiring personalization equipment characteristics, Applicant respectfully submits that there is no teaching in Dethloff of "translating the internal script into a data stream in accordance with the personalization equipment characteristics" as recited in claim 25.

In addition, Dethloff at column 16, lines 24-37 refers to FIG 19 and FIG. 20. Column 16, lines 24-26 states, "FIG. 19 is a perspective view of a (M-) ViVo card return machine 1801, which accepts at the place of the visitor's departure, the return ViVo card. Further, at column 16, lines 32-35, "FIG. 20 is a block diagram of the machine of FIG. 19, including a processing unit 1901, a program memory 1902, an interim PIN memory 1903, the general visitor file 1904, and the machine's journal and audit file 1905. FIG. 21 shows a flowchart which explains the ViVo card return operation and card return machine function." For reasons analogous to those stated above with regards to FIG. 17, Applicant respectfully submits that there is not a teaching in either FIG. 19, FIG 20, or in FIG. 21 of "acquiring personalization equipment characteristics for particular personalization equipment" as recited in claim 25.

Thus, Dethloff does not teach each element of claim 25 because Dethloff does not teach "acquiring personalization equipment characteristics for particular personalization equipment. . ." and "translating the internal script into a data stream in accordance with the personalization equipment characteristics."

Claims 26-34 depend, directly or indirectly, on claim 25 and are patentable over Dethloff for the reasons argued above, and are also patentable in view of the additional elements which they provide to the patentable combination.

Claims 35-41. Independent claim 35 recites "...streaming the plurality of program commands to the particular personalization equipment to issue the portable programmable data carrier." And independent claim 38 recites "...to transfer the program commands to the

particular personalization equipment to issue a smart card.” Applicant respectfully submits that Dethloff does not teach issuing portable programmable data carriers or smart cards.

Dethloff states “It is one object of the present invention, therefore, to provide a system wherein a card issued to a single cardholder or user, comprise means controllable by the cardholder at any time after issuance or re-issuance, to assign rights to third parties, to change and cancel such rights and to assign additional designations and values to data stored in the card. The cardholder and the sub-user can also change designations and values of data originally assigned to such data by the issuer(s), all within the scope of the original rights, terms and conditions of the issuer(s).” (*See Dethloff at column 5, line 66 to column 6, line 8*).

Dethloff states “These means further allow the cardholder or the issuer, after issuance or re-issuance of the card, to assign different values to one unit, change the designations of units and assign additional designation to a unit, all within the scope of the original extent of terms, and credit values initialized or reissued by the issuer(s). (*See Dethloff at column 5, lines 30-35*).

Thus, Dethloff does not teach each element of claims 35 and 38 because Dethloff does not teach “streaming the plurality of program commands to the particular personalization equipment to issue the portable programmable data carrier” or “. . .to transfer the program commands to the particular personalization equipment to issue a smart card.”

Claims 36-37 and 39-41 depend, directly or indirectly, on claims 35 and 38, respectively, and are patentable over Dethloff for the reasons argued above, and are also patentable in view of the additional elements which they provide to the patentable combination.

Claims 42-44. Claim 42 recites a data structure having “a chip field,” “a master file field,” “a system file field,” and “an equipment field containing data representing an identifier for personalization equipment used by a personalization system to program the microprocessor identified by the chip field.” Applicant respectfully submits that Dethloff does not teach data structures with any of these fields and, in particular, does not teach an equipment field.

As discussed above the phrase “personalization equipment” do not appear in Dethloff. The Applicant’s previous response provides a more detailed discussion of the term “personalization equipment” and cites examples from the specification of types of personalization equipment. Applicant respectfully submits that there is no teaching in Dethloff of “an equipment field containing data representing an identifier for personalization equipment

used by a personalization system to program the microprocessor identified by the chip field " as recited in claim 42.

Claims 43-44 depend, directly or indirectly, on claim 42 and are patentable over Dethloff for the reasons argued above, and are also patentable in view of the additional elements which they provide to the patentable combination.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 349-9592 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

DAVID R. TUSHIE ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 349-9592

Date Oct. 29, 2004

By Ann M. McCrackin
Ann M. McCrackin
Reg. No. 42,858

"Express Mail" mailing label number: EV496165659US

Date of Deposit: October 29, 2004

This paper or fee is being deposited on the date indicated above with the United States Postal Service pursuant to 37 CFR 1.10, and is addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.